

**UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT
CASE NO. 20-5409**

ALAN RUPP

PLAINTIFF-APPELLANT

v.

THE COURIER-JOURNAL

DEFENDANT-APPELLEE

Appeal from the United States District Court
For the Western District of Kentucky
Case No. 3:18-cv-00277

BRIEF OF APPELLANT, ALAN RUPP

Respectfully submitted,

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UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT

Disclosure of Corporate Affiliations and Financial Interest

Sixth Circuit
Case Number: 20-5409 Case Name: Alan Rupp v. The Courier-Journal, Inc.

Name of counsel: Donald L. Cox

Pursuant to 6th Cir. R. 26.1, Alan Rupp
Name of Party

makes the following disclosure:

1. Is said party a subsidiary or affiliate of a publicly owned corporation? If Yes, list below the identity of the parent corporation or affiliate and the relationship between it and the named party:

No

2. Is there a publicly owned corporation, not a party to the appeal, that has a financial interest in the outcome? If yes, list the identity of such corporation and the nature of the financial interest:

Gannett Co., Inc., owner of Defendant

CERTIFICATE OF SERVICE

I certify that on May 4, 2020 the foregoing document was served on all parties or their counsel of record through the CM/ECF system if they are registered users or, if they are not, by placing a true and correct copy in the United States mail, postage prepaid, to their address of record.

s/Donald L. Cox
Counsel for Appellant, Alan Rupp

This statement is filed twice: when the appeal is initially opened and later, in the principal briefs, immediately preceding the table of contents. See 6th Cir. R. 26.1 on page 2 of this form.

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STATEMENT IN SUPPORT OF ORAL ARGUMENT

The Appellant, Alan Rupp believes that oral argument would be beneficial. The District Court's Memorandum, Opinion and Order dismissing the Appellant, Alan Rupp's Complaint for trademark infringement pursuant to Fed. R. Civ. P. 12(b)(6) conflates the analysis of a non-trademark use defense with a likelihood of confusion analysis without conducting an appropriate analysis of the facts in the record or properly applying the relevant law concerning the likelihood of confusion. As a result, the District Court ignored the standard in trademark cases that dismissal for failure to state a claim for relief is appropriate in only the *most extreme* cases because the likelihood of confusion is generally a question of fact. Contrary to the findings of the District Court, Mr. Rupp's Complaint combined with the exhibits attached to the Complaint, clearly created sufficient facts that would preclude the granting of a motion to dismiss.

STATEMENT OF JURISDICTION

The present action is a trademark infringement action arising, in part, pursuant to 15 U.S.C. §1114. The United States District Court for the Western District of Kentucky exercised original jurisdiction over this trademark infringement action in accordance with 15 U.S.C. §1121(a) and 28 U.S.C. §1332 because it arose under federal law. The United States Court of Appeals for the Sixth Circuit has appellate jurisdiction over this matter pursuant to 15 U.S.C. §1221(a), because it arises out of a trademark infringement action under 15 U.S.C. §1114.

The District Court entered its Memorandum Opinion and Order on March 19, 2020, dismissing all claims asserted by the Appellant, Alan Rupp's Complaint. [Memorandum Opinion and Order, R.21, Page ID#s 174-183]. Mr. Rupp timely filed his Notice of Appeal on April 17, 2020. [Notice of Appeal, R.23, Page ID#s 185-186]. Accordingly, this appeal is from a final order or judgment that disposes of all parties' claims.

STATEMENT OF ISSUES

The issues on appeal are whether, as a matter of law, the District Court properly granted the Appellee, the Courier-Journal, Inc.’s Motion to Dismiss the Complaint of the Appellant, Alan Rupp for trademark infringement. The District Court’s Opinion ruled, in part, that simply using the words of a trademark does not constitute a trademark infringement and/or that different types of products or ingredients cannot constitute infringement despite the express law to the contrary. In addition, the District Court found the Complaint failed to allege with specificity how there was a likelihood of confusion with Mr. Rupp’s trademark DERBY-PIE®¹ even though Mr. Rupp’s Complaint asserted sufficient facts to state a plausible claim to relief for trademark infringement relating to the Appellee, the Courier-Journal’s Derby Day publication of the Captain’s Quarters chocolate-walnut bourbon pie under the title “Bourbon makes this Derby pie a state original” and/or the “Derby Pie” macarons sold by Derby City Macarons. Mr. Rupp submits that these rulings by the District Court constitute clear error and should be reversed and remanded for further proceedings.

¹ The District Court rejected the Courier-Journal’s primary argument for dismissal, i.e., that the First Amendment provides complete immunity from Lanham Act claims. [Memorandum, Opinion and Order, R.21, Page ID#s 177-178.]

STATEMENT OF THE CASE

A. The Instant Litigation

DERBY-PIE® (sometimes “Derby-Pie”) is an incontestable federal trademark first registered on October 7, 1969 and last renewed on January 13, 2009. Beginning at least as early as 1954 and continuing to date, the Appellant, Mr. Alan Rupp (“**Mr. Rupp**”), his family predecessors, and their licensees, have applied the Derby-Pie® trademark to a well-known chocolate nut pie and other products sold on a nationwide basis, which as those who have had it know, cannot be successfully reproduced. Needless to say the Derby-Pie name is the cornerstone of Plaintiff’s business. For decades, the Appellee, the Courier-Journal, Inc. (“**the Courier-Journal**”) has been aware of and frequently written about the Derby-Pie mark, its significance, and Mr. Rupp’s continuing enforcement battles. In an article titled, “*What’s in a Name? It’s what separates a Derby-Pie® from any other chocolate nut pie,*” the Courier stated: “*If you buy something called Derby-Pie®, you know it’s made in Kern’s Kitchen and will have walnuts and vanilla. Chocolate nut pie, on the other hand, is a generic term for a pie that might have walnuts and vanilla, or it may have pecans and vanilla.*” [Plaintiff’s Response to Motion to Dismiss, R.17-1, Page ID#s 108-111].

More importantly, the Courier-Journal has repeatedly acknowledged the mark's validity. [Plaintiff's Response to Motion to Dismiss, R.17, Exhibits A and B, Page ID#s 108-113]. For example, on April 9, 2008, it published an article for a "chocolate chip pecan pie," stating: "*Kern's Kitchen owns the exclusive trademark to the name Derby-Pie, and far be it from [sic] us to infringe on such a well-litigated tradition.*" [Plaintiff's Response to Motion to Dismiss, R.17-2, Page ID#s 112-113]. This article was later republished verbatim on November 12, 2014—just in time for some Thanksgiving-themed newspaper sales. [Plaintiff's Response to Motion to Dismiss, R.17-3, Page ID#s 114-115].

But despite its repeated acknowledgment of the validity of the Derby-Pie[®] trademark, the Courier-Journal willfully infringed the Derby-Pie trademark by publishing "informational" articles, both hard-copy and online, during Derby Week in 2017, hoping to pique the interest of its readers and sell its publications. For example, on May 6, 2017, the Courier-Journal published an article titled, "*Bourbon Makes This Derby Pie a State Original,*" which sets forth Captain's Quarter's infringing recipe— *complete with its prefab frozen pastry shell . . .* [Plaintiff's Response to Motion to Dismiss, R.17-4, Page ID#s 116-117]. Subsequently, on June 22, 2017, the Courier-Journal reported on Derby City Macarons' new location by featuring a large photo of macarons

with a caption stating: “*Derby Pie*, Mint Julep and Peach Tea macarons from Derby City Macarons.” [Plaintiff’s Response to Motion to Dismiss, R.17-5, Page ID#s 118-119].

Immediately after the Courier’s publication of Captain’s Quarter’s so-called “original” Derby Pie recipe, it was informed of its infringement. [Plaintiff’s Response to Motion to Dismiss, R.17-7, Page ID#s 120-125]. “On Derby Day, it [the Courier-Journal] published a recipe for ‘Derby-Pie.’ Now, your client has known for at least thirty years of the existence of this trademark and, indeed, has covered litigation over the years about the trademark. This constitutes knowing infringement and we need to discuss an appropriate form of redress.” [Plaintiff’s Response to Motion to Dismiss, R.17-6, Page ID# 121]. In spite of this notification of possible infringement, about two weeks later, the Courier-Journal published the so-called Derby Pie Macaron article. [Plaintiff’s Response to Motion to Dismiss, R.17-5, Page ID#s 118-119].

B. Abbreviated History of Prior Relevant Derby-Pie® Litigation

The Derby-Pie® trademark has been litigated on numerous occasions, including in the Kentucky federal courts, of which the Court may take judicial notice. [Plaintiff’s Response to Motion to Dismiss, R.17-7, Page ID#s 126-149]. Significantly, in Kern’s Kitchen, Inc. v. Bon Appetit, in a fact pattern

virtually identical to this Action, the well-known magazine published a so-called “Derby Pie” recipe in a cookbook. [Plaintiff’s Response to Motion to Dismiss, R.17-7, Page ID#s 136-138]. Ultimately, there, the Sixth Circuit reversed the District Court’s decision finding the Derby-Pie® mark generic. [Plaintiff’s Response to Motion to Dismiss, R.17-7, Page ID# 137]. Likewise, in Kern’s Kitchen, Inc. v. PBS, PBS aired a television program where a fake Derby-Pie was baked. [Plaintiff’s Response to Motion to Dismiss, R.17-7, Page ID#s 139-140]. Ultimately, the national television program was enjoined by the United States District Court for the Western District of Kentucky from broadcasting the offending or similar episodes by an agreement between the parties. [Plaintiff’s Response to Motion to Dismiss, R.17-7, Page ID#s 139-140].

The Courts have previously recognized the extent of Mr. Rupp’s trademark which is relevant to the facts in this case. In Kern’s Kitchen, Inc., et al v. Nestle Food Company, C-93-0735-L-J, the United States District Court for the Western District of Kentucky entered a Final Judgment and Permanent Injunction against Nestle which included the finding “The use of the trademark DERBY-PIE®, *or any colorable imitation thereof*, in conjunction with a recipe for a chocolate nut product infringes the trademark DERBY-PIE®.” [Plaintiff’s Response to Motion to Dismiss, R.17-7, Page

ID#s 141] (emphasis added). In Kern’s Kitchen, Inc., etc. v. Chapters Publishing, LTD, 3:96-CV-809-S, the United States District Court for the Western District of Kentucky entered an Agreed Final Judgment in a trademark infringement case involving a publisher, like the Courier-Journal, that published a recipe for a Southern Style pecan pie that included whiskey as one of its ingredients. The Agreed Final Judgment entered by the Court imposed a permanent injunction against Chapters infringement and stated, “Chapters Publishing, Ltd. (“Chapters”), admits that it used SOUTHERN STYLE DERBY-PECAN PIE as a title for a recipe in The Book of Bourbon and Other Fine American Whiskeys, but Chapters does not admit any liability for its actions.” [Plaintiff’s Response to Motion to Dismiss, R.17-7, Page ID# 143].

Finally, in Kern, et al. v. Wilson, et al, the United States District Court for the Western District of Kentucky its Findings of Fact, Conclusions of Law and Memorandum Opinion that issued a preliminary injunction against yet another infringer, enjoining publication of an imitation “Derby-Pie” recipe. [Plaintiff’s Response to Motion to Dismiss, R.17-7, Page ID#s 127-135]. In so doing, Judge Allen determined:

In 1954, the plaintiff Leandra C. Kern and her husband, now deceased, the grandparents of plaintiff Alan Rupp, were engaged in preparing for the Melrose Inn at Prospect, Kentucky a pastry

which has its chief ingredients chocolate and nuts. Melrose Inn was a very satisfied customer, and the Kerns decided to invent a name for the product and came up with the name “Derby Pie.” For some fifteen years thereafter, the Kerns sold Derby Pies to various restaurants, country clubs and delicatessens in the Louisville area . . .

[Plaintiff’s Response to Motion to Dismiss, R.17-7, Page ID# 127]. The Court went on to find:

In the instant case, where the reference in the book is made explicitly to the identical words “Derby Pie” and where no reference appears as to plaintiffs being the originator thereof, there exists the likelihood that the reading public will assume that the pie described in the recipe is, in fact, identical with the pie produced by the plaintiffs. The fact that plaintiffs and defendant Wilson are not actual direct competitors does not give the defendants the right to confuse the public as to the plaintiffs’ trademark, since the courts have universally held that a plaintiff holding a trademark in a particular industry or field may enjoin the use of it by organizations or individuals in fields that are not directly related to the plaintiffs’ business. See Continental Motors Corporation v. Continental Aviation Corporation, 375 F.2d 857 (5th Cir. 1967).

[Plaintiff’s Response to Motion to Dismiss, R.17-7, Page ID# 133].

It is against this background and record that the District Court’s decision to dismiss Mr. Rupp’s Complaint must be evaluated.

SUMMARY OF THE ARGUMENT

The District Court's erred when it entered its Memorandum, Opinion and Order dismissing the Complaint of Mr. Rupp pursuant to Fed. R. Civ. P. 12(b)(6). In the context of trademark infringement cases, such as the one presented here, this Court has held, "[g]enerally, 'dismissal for failure to state a claim upon which relief can be granted is appropriate in only the most extreme trademark infringement cases, such as where goods are unrelated as a matter of law, since the likelihood of confusion is generally a question of fact.' 32 *Federal Procedure, Lawyer's Edition* §74:507 (2008)." Hensley Manufacturing, Inc. v. Propride, Inc., 579 F.3d 603, 613 (6th Cir. 2009). Attached to his Complaint, Mr. Rupp attached the offending articles of the Appellee, the Courier-Journal which established the use of Mr. Rupp's DERBY-PIE® trademark; numerous court rulings that enforced Mr. Rupp's trademark, even in cases which dissimilar products; several articles published by the Courier-Journal that recognized Mr. Rupp's trademark and the express notification that the offending articles constituted a knowing violation of Mr. Rupp's trademark.

Rather than recognize that Mr. Rupp had asserted a plausible claim for relief, the District Court imposed a heightened pleading standard to Mr. Rupp's claims and also conducted a likelihood of confusion analysis that

improperly focused on slightly different ingredients rather than recognize the law relating to trademarks that “[D]issimilarity is not dispositive of the likelihood of confusion inquiry. A likelihood of confusion may exist even if the parties are not in direct competition, ... or their products or services are not identical Rather, because the rights of an owner of a registered trademark extend to any goods that might be, in the minds of the public is likely to attribute the products ... to a single source.” Board of Regents of the University of Wisconsin System v. Phoenix International Software, Inc., 653 F.3d 448, 455 (7th Cir. 2011).

As such, Mr. Rupp submits that the District Court erred as a matter of law when it dismissed Mr. Rupp’s Complaint and this matter should be reversed and remanded for further proceedings consistent with this ruling.

ARGUMENT

A. The District Court erred in granting the Motion to Dismiss.

This Court has held “[w]e review de novo ... the district court’s grant of a Rule 12(b)(6) motion to dismiss ...’ *Seaton v. TripAdvisor LLC*, 728 F.3d 592, 596 (6th Cir. 2013).” *Croce v. New York Times Company*, 930 F.3d 787, 792 (6th Cir. 2019).

This court reviews *de novo* a district court’s grant of a motion to dismiss under Federal Rule of Civil Procedure 12(b)(6). *Jones v. City of Cincinnati*, 521 F.3d 555, 559 (6th Cir. 2008). A complaint will survive a motion to dismiss if the plaintiff alleges facts that “state a claim to relief that is plausible on its face” and that, if accepted as true, are sufficient to “raise a right to relief above the speculative level.” *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 555, 570, 127 S. Ct. 1955, 167 L.Ed.2d 929 (2007); *see also Ashcroft v. Iqbal*, 556 U.S. 662, 678, 129 S. Ct. 1937, 173 L.Ed.2d 868 (2009). When reviewing a motion to dismiss under Rule 12(b)(6), a court must “construe the complaint in the light most favorable to the plaintiff, accept its allegations as true, and draw all reasonable inferences in favor of the plaintiff.” *Handy-Clay v. City of Memphis*, 695 F.3d 531, 538 (6th Cir. 2012).

Cook v. Ohio National Life Insurance Company, 2020 WL 3056228, *3 (6th Cir. 2020).

“A claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged.” *Ashcroft v. Iqbal*, 556 U.S. 662, 678, 129 S. Ct. 1937, 173 L.Ed.2d 868 (2009). The court must view the allegations in the complaint in the light most favorable to the plaintiff, treating all well-

pleaded facts as true, but need not accept bare legal conclusions as definitive. Tackett v. M & G Polymers, USA, LLC, 561 F.3d 478, 488 (6th Cir. 2009).

In the context of trademark infringement cases, this Court has held, “[g]enerally, ‘dismissal for failure to state a claim upon which relief can be granted is appropriate in only the most extreme trademark infringement cases, such as where goods are unrelated as a matter of law, since the likelihood of confusion is generally a question of fact.’ 32 *Federal Procedure, Lawyer’s Edition* §74:507 (2008).” Hensley Manufacturing, Inc. v. Propride, Inc., 579 F.3d 603, 613 (6th Cir. 2009).

In its analysis, the District Court held “[h]ere, the Complaint fails to plausibly establish that Defendant used Plaintiff’s Mark in any other way than a non-trademark one. In fact, Plaintiff’s skeletal Complaint fails to allege with specificity how there is a ‘likelihood of confusion.’” [Memorandum Opinion and Order, R.21, Page ID# 180]. In reaching this conclusion, the District Court focused only on the text of Paragraphs 8, 9 and 10 of the Complaint, ignoring the exhibits attached to the Complaint and specifically incorporated within those paragraphs. [Memorandum Opinion and Order, R.21, Page ID# 180]. The exhibits include numerous instances where the Courier-Journal either expressly acknowledged Mr. Rupp’s trademark or was specifically advised that articles and recipes it was publishing regarding a chocolate chip

nut pie was subject to the trademark claims of the Appellee, Alan Rupp. [Complaint, R.1, Exhibits B, C, D, E and F, Page ID#s 9-33]. Exhibit E to the Complaint included a 1992 article published by the Appellee recognizing that “If you buy something called Derby-Pie®, you know it’s made by Kern’s Kitchen and will have walnuts and vanilla.” [Complaint, R.1, Page ID# 24].

In addition to the foregoing, Paragraph 20 states “[t]he actions of the Defendant in infringing and diluting Plaintiff’s trademark and/or trade name, both directly and indirectly, in engaging in unfair competition, *and in passing off its goods as those of the Plaintiff*, have damaged Plaintiff in an amount in excess of \$250,000.” [Complaint, R.1, Page ID# 4] (emphasis added). See also Paragraph 21 of Appellant’s Complaint which asserts similar claims. [Complaint, R.1, Page ID# 4]. While this Court has recognized that “[t]he factual allegations, assumed to be true, must do more than create speculation or suspicion of a legally cognizable cause of action; they must show *entitlement to relief.*’ *League of United Latin Am. Citizens v. Bredesen*, 500 F. 3d 523, 527 (6th Cir. 2007) (emphasis in the original). This standard does ‘not require heightened fact pleading of specifics, but only enough facts to state a claim to relief that is plausible on its face.’” *Oaklawn Jockey Club, Inc. v. Kentucky Downs, LLC*, 687 Fed. Appx. 429, 431 (6th Cir. 2017) (internal citations omitted).

“Likewise, a detailed description explaining how Defendant used the confusingly similar mark, is not required for Plaintiff’s claims to survive Rule 12(b)(6) scrutiny, Plaintiff merely needs to allege, and has alleged, ‘sufficient factual matter’ that demonstrates the elements of trademark infringement: that Plaintiff owns the first design mark; Defendant used the mark (or a confusingly similar mark) in commerce; and the use was likely to cause confusion. *See Iqbal*, 556 U.S. at 678, 129 S.Ct. 1937; *see also in re Travel Agent Comm’n Antitrust Litig.*, 583 F.3d 896, 903 (6th Cir. 2009) (explaining that a court must ‘construe the complaint in the light most favorable to the plaintiff, accept its allegations as true, and draw all reasonable inferences in favor of the plaintiff’).” Capital Grille Holdings, Inc. v. Historic Hotels of Nashville, LLC, 2020 WL 1332401, *10 (M.D. TN, 2020).

Accordingly, taken together, it is self-evident that the allegations in the Complaint combined with the facts established by reason of the Exhibits to the Complaint sufficiently assert a claim for relief that is plausible on its face. The Exhibits to the Complaint included the offending articles, articles establishing that the Courier-Journal was aware of Mr. Rupp’s trademark, relevant court decisions that upheld Mr. Rupp’s trademark and the specific notification from counsel for Mr. Rupp that the articles that had been published constituted a knowing infringement of Mr. Rupp’s trademark.

[Complaint, R.1 through R.1-6, Page ID#s 1-32]. Contrary to the findings of the District Court, there is no heightened pleading requirement that would require Mr. Rupp's Complaint to "allege with specificity how there is a 'likelihood of confusion'" in order to survive Rule 12 (b)(6) scrutiny. [Memorandum Opinion and Order, R.21, Page ID# 180].

B. The District Court erred in finding that Appellee used Appellant's trademark in a non-trademark way and/or there was no likelihood of confusion.

The Memorandum, Opinion and Order of the District Court granting the Appellee's Motion to Dismiss, conflates the concepts of non-trademark use and the likelihood of confusion to support its decision. Such action is contrary to the law.

First, the District Court finds that Appellant "...fails to establish that Defendant [Appellee] used Plaintiff's Mark [DERBY PIE®] in any other way that a non-trademark one." [Memorandum Opinion and Order, R.21, Page ID# 180]. In support of its analysis, the District Court cites to the cases of Hensley Manufacturing, Inc., supra, and Oaklawn Jockey Club, Inc. v. Kentucky Downs, LLC, 687 Fed. Appx. 429 (6th Cir. 2017). Both of these cases are distinguishable on their respective facts and certainly don't support the granting of the Courier-Journal's Motion to Dismiss.

In Hensley, this Court considered a situation where an individual, by the name of Jim Hensley, sold a trailer hitch business as a going concern with the name Hensley Manufacturing. Following the sale, Mr. Hensley began working for a different company by the name of ProPride, Inc. for whom Mr. Hensley designed a new trailer hitch system. ProPride marketed the new system as the “ProPride Pivot Point Projection Hitch” or the “3P Hitch”. (Hensley Manufacturing, Inc., 579 F.3d at 607). At issue were ProPride’s advertisements that referenced Jim Hensley but never referred to the Plaintiff’s trademarks of “Hensley” or “Hensley Arrow” other than to state that Jim Hensley previously developed trailer hitch systems and had now developed a new system. The advertisements clearly stated that Jim Hensley was no longer affiliated with Hensley Manufacturing. (Hensley Manufacturing, Inc., 579 F.3d at 608). This Court agreed with the District Court in that case that a Motion to Dismiss was appropriate because the advertisements of ProPride never actually used the trademark terms of “Hensley”, “Hensley Arrow” or even “Jim Hensley” in relation to its trailer hitch system. Moreover, while the advertisements identified Jim Hensley as the designer, they clearly stated that Jim Hensley was no longer affiliated with Hensley Manufacturing and ProPride’s own name appeared on the advertisements on numerous occasions. (Hensley Manufacturing, Inc., 579

F.3d at 611). Based upon this clear evidence of record, this Court upheld the dismissal due to a non-trademark use.

The second case cited by the District Court is Oaklawn Jockey Club, Inc. v. Kentucky Downs, LLC, 687 Fed. Appx. 429 (6th Cir. 2017). In this case, owners of horse racing tracks filed suit against a company that had developed an online historical-race gambling platform. These computer-generated horse races allowed users to place a wager on a historical race that was presented to the user in an anonymous fashion until after the wager was placed. Once placed, the platform showed a computer-generated race that did not attempt to recreate the actual race, only the results. At some point, the platform briefly displayed the track information concerning each historical race which used the name of the tracks where the race took place. In rejecting the claims of the Track Owners, this Court held the use of the trademarks of the claimants were proceeded by the word “Location” to designate where the historical race took place and that such “... would not confuse consumers into believing the videos were provided by Plaintiffs [Track Owners].” (Oaklawn Jockey Club, Inc., 687 Fed. Appx. at 433).

Such factors simply do not exist in this case. The Courier-Journal’s article about the Captain’s Quarters chocolate walnut bourbon pie included a headline that clearly uses the trademark “Derby pie”. [Complaint, R.1-2, Page

ID# 10]. The article was published on May 6, 2017, which was the first Saturday in May in 2017, or Derby Day. [Complaint, R.1-2, Page ID# 10]. The article concerning the macarons doesn't even attempt to avoid the use of the trademark and specifically states that Derby City Macarons sells "Derby Pie" macarons. [Complaint, R.1-3, Page ID# 12]. While both articles reference entities other than Kerns Kitchen in relation to each product, such references are not "explicitly and repeatedly" identified nor does such inclusion create a situation where no question of fact exists regarding consumer confusion that would justify a finding on a Motion to Dismiss that the issue of non-trademark use was clear and unmistakable. Indeed, taken to its logical conclusion, according to the District Court, anytime a competitor uses a trademark in conjunction with its own name it is immunized from a claim of infringement.

As indicated above, the facts here are strikingly similar to the facts presented in the Chapters Publishing, LTD, decision. [Plaintiff's Response to Motion to Dismiss, R.17-7, Page ID#s 143-145]. There, the same District Court recognized the existence of the trademark infringement when a publisher printed a recipe for a Derby Pecan Pie that included whiskey as an ingredient. As a result, the Court in that instance, entered an Agreed Final Judgment precluding the use of SOUTHERN STYLE DERBY-PECAN PIE

as a title for a recipe in The Book of Bourbon and Other Fine American Whiskeys. [Plaintiff's Response to Motion to Dismiss, R.17-7, Page ID# 143]. Despite that fact that this decision was submitted to the District Court as an attachment to both Mr. Rupp's Complaint and his Response in Opposition to the Courier-Journal's Motion to Dismiss, the District Court nevertheless found that the Captain Quarter's recipe for a "Derby-Pie" chocolate-walnut bourbon pie did not infringe on Mr. Rupp's trademark because it included bourbon! [Memorandum, Opinion and Order, R.21, Page ID# 181]. Apparently, despite the prior ruling in Chapters Publishing, LTD, the District Court is now of the opinion that a publisher can avoid trademark infringement by using a recipe that includes slightly different ingredients and includes a denial that it is a recipe for DERBY-PIE® despite the publication of the recipe being on Derby Day and despite the reference in the title to "Derby pie". [Plaintiff's Response to Motion to Dismiss, R.17-4, Page ID# 117].

The District Court's Memorandum, Opinion and Order goes on to attempt a truncated likelihood of confusion analysis. In the Sixth Circuit "[t]his Court considers the question of whether there is a likelihood of confusion to be a mixed question of fact and law. *See Data Concepts, Inc. v. Digital Consulting, Inc.*, 150 F.3d 620, 624 (6th Cir. 1998) *abrogated on other*

grounds by Hana Fin., Inc. v. Hana Bank, - U.S.-, 135 L.Ed.2d 800 (2015). Any dispute about the evidence that pertains to the eight factors presents a factual issue. *Id.* at 624 (noting that “[i]f the facts relevant to the applicable factors are contested, factual findings must be made with respect to each of these factors’).” Progressive Distribution Services, Inc. v. United Parcel Service, Inc., 856 F.3d 416, 427 (6th Cir. 2017).

At the outset, the District Court’s decision finding that no likelihood of confusion existed failed to make findings of fact regarding each of the factors. Instead of applying the eight-factor likelihood of confusion analysis, the District Court’s Memorandum, Opinion and Order provided a truncated analysis of each article published by the Courier-Journal. “In Article 1, ‘Chocolate-walnut bourbon pie from Captain’s Quarters’ identifies the source of the recipe as Captain’s Quarters, not DERBY-PIE®. This is analogous to using ‘Derby’ to modify ‘horse’, ‘hat’, or ‘party’ and does not constitute an impermissible use of the Mark.” [Memorandum, Opinion and Order, R.21, Page ID# 181]. Relying on Sazerac Brands, LLC v. Peristyle, LLC, 3:15-CV-00076-GFVT, 2017 WL 4558022, at *5 (E.D. Ky. July 14, 2017) *aff’d*, 892 F.3d 853 (6th Cir. 2018), the District Court held, “[A] party does not violate trademark law solely by using words another has trademarked.” [Memorandum, Opinion and Order, R.21, Page ID# 181].

This citation by the court is not only wrong as a matter of law for use of another's name in conjunction with an aligned product, is the definition of trademark infringement, but the circumstances in Sazerac are completely different than those here. In Sazerac, the court found that the name Old Taylor was being used in a geographic sense to nominate the distillery taken over by Sazerac, which at one time, many decades ago, had produced Old Taylor Bourbon, thus, the Old Taylor distillery. Identifying a particular distillery as the source of a product six decades ago we agree is not infringement. But that is not what happened here. We are not talking about the old Derby Pie bakery, or some such thing, what we are talking about is the Courier-Journal reporting on a restaurant, which is said to make a Derby Pie containing bourbon. The District Court confused the geographic use of a mark, which is notoriously exempt from infringement claims, from the use of a mark of the same genre as the trademark.

The situation with respect to Article 2 relating to the "Derby Pie" macarons, alleges that Derby Pie is being used in a non-trademark way. Again, this ruling ignores the fact that the DERBY-PIE® trademark has been registered for approximately 50 years and is uncontestable. [Plaintiff's Response to Motion to Dismiss, R.17-7, Page ID# 130]. The fact that a particular baking product, such as a cookie or a cake, is not a pie, does not in

any way denigrate the existence of the DERBY-PIE® trademark when applied to these products. [Plaintiff's Response to Motion to Dismiss, R.17-7, Page ID#s 148-149] (Agreed Permanent Injunction entered for a Derby Pie *ice cream*).

Confusion can be likely in two situations: (1) on a source basis, where the public believes that the infringing product is made by the trademark owner or (2) on an associational or sponsorship basis, where the public believes that the infringing product is affiliated with or approved by the trademark owner. Promotional mark likelihood of confusion tends to be the later, confusion as to the sponsorship or approval of the products rather than their "literal source of manufacture." In fact, likelihood of confusion as to whether a party "produces, licenses or otherwise endorses" another's goods has been called the "promotional goods" doctrine.

Jerome Gilson (original author 1974-2015) (Anne Gilson Lalonde), *Gilson on Trademarks*, §5.05[5] (2019). "[T]he question is not whether people will confuse the marks, but rather whether the marks will confuse people into believing that the goods they identify emanate from the same source." Paula Payne Products, Co. v. Johnson's Publishing Company, 473 F.2d 901, 902 (C.C.P.A. 1973). "[T]he ... mistaken belief that [a good] is manufactured or sponsored by the same entity [as another good] ... is precisely the mistake that §2(d) of the Lanham Act seeks to prevent." In re Majestic Distilling, Co., 315 F.3d 1311, 1316 (Fed. Cir. 2013). Finally, see Board of Regents of the University of Wisconsin System v. Phoenix International Software, Inc., 653

F.3d 448, 455 (7th Cir. 2011) “[D]issimilarity is not dispositive of the likelihood of confusion inquiry. A likelihood of confusion may exist even if the parties are not in direct competition, ... or their products and services are not identical Rather, because the rights of an owner of a registered trademark extend to any goods that might be, in the minds of the public is likely to attribute the products ... to a single source.” (citing, CAE, Inc. v. Clean Air Eng’g, Inc., 267 F.3d 660, 679 (7th Cir. 2001)).

Applying this law to the offending articles of the Courier-Journal, it is clear that a likelihood of confusion exists. In relation to the recipe of a chocolate-walnut bourbon pie from Captain’s Quarters, the headline of the article clearly uses the DERBY-PIE® trademark. The recipe was published on Derby Day. The obscure reference to this recipe being provided by Captain’s Quarters is not sufficient to avoid the conclusion that there would be confusion on whether Mr. Rupp either sponsored or approved of this product. The reference to the slight variation where the recipe uses bourbon does not defeat this conclusion. As to the Derby Pie macarons, there isn’t any attempt to disguise the use of Mr. Rupp’s trademark. The District Court’s simplistic conclusion that because a macaron is not a pie that there can be no likelihood of confusion is simply contrary to the law.

The District Court's Memorandum, Opinion and Order represents a fundamental misunderstanding of trademarks. Trademarks are not patents. Mr. Rupp does not have to establish that a product which bears the DERBY-PIE name also contains the same ingredients nor does the product have to be a pie. Such cross-over misunderstanding grossly denigrates applicable trademark rights. To put it bluntly, if a confectionary product bears the name Derby Pie, it infringes Mr. Rupp's trademark. The District Court also confuses the source of the product in such a way as to eliminate the entire concept of trademarks. Trademarks are granted to protect source. A different source simply does not eliminate infringement. Rather, it is the essence of infringement.

CONCLUSION

Accordingly, the Appellant, Alan Rupp requests this Court to reverse the District Court's grant of Appellee, the Courier-Journal's Motion to Dismiss and remand for further proceedings consistent with this ruling. Mr. Rupp's Complaint asserts a plausible claim for trademark infringement and, contrary to the findings of the District Court, claims for trademark infringement are not subject to heightened pleading requirements. Simply put, the present case does not present such an extreme trademark case that would support the District Court's dismissal.

Respectfully submitted,

/s/Donald L. Cox

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CERTIFICATE OF SERVICE

Undersigned counsel hereby certifies that on this 30th day of June 2020, a true and correct copy of the foregoing was filed with the Clerk of the Court using its CM/ECF filing system, which will send electronic notice of this filing to all parties registered to receive notice in this case.

/s/ Donald L. Cox

**APPELLANT'S ADDENDUM: DESIGNATION
OF DISTRICT COURT DOCUMENTS**

| Record Entry No. | Description of Document | Page ID No. |
|-----------------------------|--|--------------------|
| 1 | Complaint | 1-6 |
| 1-1 | Exhibit A to the Complaint; Notice of Acceptance of § 8 Declaration and § 9 Renewal of DERBY-PIE trademark. | 7-8 |
| 1-2 | Exhibit B to the Complaint; Copy of May 6, 2017 Courier-Journal article about Captain's Quarters chocolate-walnut bourbon pie. | 9-10 |
| 1-3 | Exhibit C to the Complaint; Copy of June 22, 2017 Courier-Journal article about Derby City, Derby Pie macarons. | 11-12 |
| 1-4 | Exhibit D to the Complaint; January 25, 2018 screen shot of Courier-Journal website RE Derby Pie references. | 13-14 |
| 1-5 | Exhibit E to the Complaint; Various articles published by the Courier-Journal acknowledging the DERBY-PIE® trademark. | 15-26 |
| 1-6 | Exhibit F to the Complaint; May 10, 2017 Notice of trademark infringement attaching | 27-32 |

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| | copies of the offending articles of the Courier-Journal | |
| 17 | Plaintiff, Alan Rupp's Response in Opposition to Defendant, Courier-Journal's Motion to Dismiss. | 85-107 |
| 17-1 | Exhibit A to Plaintiff, Alan Rupp's Response in Opposition to Defendant, Courier-Journal's Motion to Dismiss; Copies of April 29, 1992 Courier-Journal article titled <i>What's in a name? It's what separates a Derby-Pie® from any other chocolate nut pie</i> and May 2, 2003 Courier-Journal article titled <i>Accept no substitutes for Derby-Pie.</i> | 108-111 |
| 17-2 | Exhibit B to Plaintiff, Alan Rupp's Response in Opposition to Defendant, Courier-Journal's Motion to Dismiss; April 9, 2008 Chocolate chip pecan pie recipe published by the Courier-Journal recognizing that Kerns Kitchen owns the exclusive trademark to the name Derby-Pie. | 112-113 |
| 17-3 | Exhibit C to Plaintiff, Alan Rupp's Response in Opposition to Defendant, Courier-Journal's Motion to Dismiss; November 12, | 114-115 |

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|------|--|---------|
| | 2014 Courier-Journal reprint of April 9, 2008 recipe. | |
| 17-4 | Exhibit D to Plaintiff, Alan Rupp's Response in Opposition to Defendant, Courier-Journal's Motion to Dismiss; Copy of May 6, 2017 Courier-Journal article about Captain's Quarters chocolate-walnut bourbon pie. | 116-117 |
| 17-5 | Exhibit E to Plaintiff, Alan Rupp's Response in Opposition to Defendant, Courier-Journal's Motion to Dismiss; Copy of June 22, 2017 Courier-Journal article about Derby City, Derby Pie macarons. | 118-119 |
| 17-6 | Exhibit F to Plaintiff, Alan Rupp's Response in Opposition to Defendant, Courier-Journal's Motion to Dismiss; May 10, 2017 Notice of trademark infringement attaching copies of the offending articles of the Courier-Journal. | 120-125 |
| 17-7 | Exhibit G to Plaintiff, Alan Rupp's Response in Opposition to Defendant, Courier-Journal's Motion to Dismiss; Copies of seven (7) opinions/judgments/agreed judgments concerning infringement of the DERBY-PIE® trademark. | 126-149 |

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| 21 | District Court's Memorandum, Opinion and Order dated March 19, 2020. | 174-183 |
| 22 | District Court Judgment Dismissing the action dated March 19, 2020 | 184 |